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09/606,897	06/29/2000	Shu Lin	RCA 89, 817	7641

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2653

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/606,897

Applicant(s)

LIN ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-11 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-11 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/28/02 has been entered.

It is noted that the RCE request of 8/28/02 instructed the entry of the above dated amendment after final. Additionally, a duplicate amendment dated 8/28/02 was filed along with the RCE request. Since this amendment (8/28/02) is a duplicate it has not been entered.

### ***Specification***

The amendment to the title of the invention is acknowledged, nevertheless the argued feature with respect to the reverse direction is not in the title and the examiner again requests the title to reflect such.

### ***Drawings***

In order to avoid abandonment, the drawing informalities noted in Paper No. 6, mailed on 9/20/01, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
2. Claims 6,7,20 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is noted that applicants' have canceled claim 2. Unfortunately claim 6 depends there from, and hence the examiner is not certain as to where the limitations of claim 6 are to further limit? Dependent claim 7 doesn't clarify the above and falls with its parent claim.

✓ Also, claim 20 depends from canceled claim <sup>12</sup>20 and suffers for the reasons stated above. No art has been applied to claim 20.

Claim 23 is a duplicate of claim 24. Hence the examiner is not certain as to what the distinction there between is. Further explanation is respectfully requested.

It is also noted that claim 1/23 is a duplicate of claim 21, and if allowable subject matter is found, then the procedure(s) as outlined in MPEP section 76.03 (k) would be invoked.

Claims 6,7,16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations of these claims are not quite clear. The examiner is not certain if the claims are referring to an edit ability terminating at a mid cell position or not. Further elaboration is respectfully requested. NO ART IS APPLIED TO THESE CLAIMS AT THIS TIME.

AS FAR AS THE CLAIMS RECITE POSITIVE SUBJECT MATTER, the following art rejections are made.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 8 and 11, 15 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Kondo et al further considered with Fujinami et al and both further considered with either Noguchi et al or Abecassis.

Kondo et al discloses an editing system wherein reordered positions of recorded information are provided for by rewriting start and end points in the TOC of the disc. Applicants' attention is drawn to the disclosure at col. 16 the discussion with respect to divide and combine edit functions. With respect to claim 18, the examiner interprets the display of the combining ability – see col. 18 lines 60+ to meet this limitation.

The independent claims have been amended to include a secondary ability of modifying a jump command in a forward direction. The ability of a jump (forward) for playback is taught by the Fujinami et al reference. The ability of having the control signal able to cause a jump in a forward direction is considered a logical extension of the fwd playback abilities available in DVD systems/and as further taught by the Fujinami et al reference.

It would have been obvious to one of ordinary skill in the art to modify the system of the above noted prior art systems to Kondo et al with the teaching from the Fujinami et al document, motivation is to permit a forward jump playback/scan/trick mode(s).

The independent claims have further been amended to include the ability to change the start address as required by the edit command/ability.

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✓ Noguchi et al discloses such – see the discussion with respect to figure 6, starting at col. 5 line 42 as he discusses the interruption/editing ability. The examiner interprets such as the ability to provide for the renumbering of the start address point accordingly.

Alternatively, Abecassis provides for “edit” ability / skip designated scenes/cells – see the discussion with respect to edit out starting at col. 9 line 35. Again, this provides for the system to re-designate the start point(s) accordingly. This changing of address positioning meets the limitations of claims 8, 15 and 18 as well.

It would have been obvious to modify the base system of Kondo and Fujinami et al with the additional re-designation of start points after editing as further taught by either Noguchi et al or Abecassis, motivation is to provide for the appropriate restart designation upon playback and hence have a proper edit sequence.

✓ 4. Claims 1, 8, 11, 15, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Aramaki et al and further considered with Fujinami et al and both further considered with either Noguchi et al or Abecassis.

Aramaki et al discloses an editing system wherein the management information is rerecorded to provide for update abilities – editing – see col. 36 lines 35 –50 for instance - such as skipping etc.

As far as the examiner can interpret the system of Aramaki et al – the pointers act as the ability to rewrite the start and end address points. The independent claims have been modify to include the modification of the jump command in the fwd direction.

The ability of a fwd jump/ playback is taught by the Fujinami et al reference. The further ability of having the control signal able to cause a jump in a forward direction is considered a logical extension of the fwd (and bwd) playback abilities available in DVD systems and as further taught by Fujinami et al.

It would have been obvious to one of ordinary skill in the art to modify the system of the above noted prior art system to Aramaki with the teaching from Fujinami et al, motivation is to permit a fwd jump/ playback/scan/trick mode.

The independent claims have further been amended to include the ability to change the start address as required by the edit command/ability.

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Noguchi et al discloses such – see the discussion with respect to figure 6, starting at col. 5 line 42 as he discusses the interruption/editing ability. The examiner interprets such as the ability to provide for the renumbering of the start address point accordingly.

Alternatively, Abecassis provides for "edit" ability / skip designated scenes/cells – see the discussion with respect to edit out starting at col. 9 line 35. Again, this provides for the system to re-designate the start point(s) accordingly. This ability to re-designate starting points meets the limitations of claims 8, 15 and 18 as well.

It would have been obvious to modify the base system of Aramaki and Fujinami et al with the additional re-designation of start points after editing as further taught by either Noguchi et al or Abecassis,

5. Claims 1, 8, 11, 15 and 18 are rejected under 35 U.S.C. 103(a) as obvious over Nagasawa further considered with Fujinami et al and both further considered with either Noguchi et al or Abecassis.

Nagasawa in describing the conventional editing system provides for the rerecording of the new addresses in the TOC – see col. 4 lines 8 – 12 for instance. The independent claims have been modified to include the modification of the jump command in the fwd direction.

The ability of a fwd jump/playback is taught by the Fujinami et al reference. The further ability of having the control signal able to cause a jump in a forward direction is considered a logical extension of the fwd (and bwd) playback abilities available in DVD systems and as further taught by the Fujinami et al reference.

It would have been obvious to one of ordinary skill in the art to modify the system of the above noted prior art system to Nagasawa with the teaching from Fujinami et al, motivation is to permit a fwd jump/playback/scan/trick mode.

The independent claims have further been amended to include the ability to change the start address as required by the edit command/ability.

Noguchi et al discloses such – see the discussion with respect to figure 6, starting at col. 5 line 42 as he discusses the interruption/editing ability. The examiner interprets such as the ability to provide for the renumbering of the start address point accordingly.

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Alternatively, Abecassis provides for "edit" ability / skip designated scenes/cells – see the discussion with respect to edit out starting at col. 9 line 35. Again, this provides for the system to re-designate the start point(s) accordingly. This ability to re-designate starting points meets the limitations of claims 8,15 and 18 as well.

6. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 8 and 18 above, and further in view of Uno et al.

Uno et al (relying upon PCT JP99/00208 as its filing date) teaches the ability of having an inhibit flag appropriately provided for the inherent use – see the abstract.

It would have been obvious to one of ordinary skill in the art to modify the system of the prior art as relied upon with respect to claims 8/18 with the teaching from Uno et al, motivation is to provide for the appropriate flag control ability for the inherent use as recognized in Uno et al.

7. Claims 23,24 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of either Hasegawa et al or WO 97/06531.

Claims 23 and 24 are both concerned with the same limitation(s) (method/means) and hence the examiner will only discuss the limitation(s) of claim 23. The examiner also assumes that claim 24 is dependent upon claim 11 not 1.

The ability of a reverse playback, a jump to provide a reverse direction is taught by the documents/systems in either Hasegawa et al or WO 97/06531.

The ability of further modify the above jump so as to have a bi-directional jump ability is considered a desired ability and obvious with the above teaching. Such bi-directional jumping provides for a true random editing ability – i.e., an editing not limited to a forward direction only, and hence increases the flexibility of the overall playback system.

With respect to the limitations of claim 5, which now recite the ability of changing the start point accordingly – to the end point. The examiner concludes that such is present in the above combination of references as taught by either the Noguchi et al or Abecassis system – the renumbering of the start/edit point accordingly. Hence this limitation is met by the above combination of references.



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8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above art as applied to claim 23 above, and further in view of either Greenwood et al or Tholen et al.

The ability of creating edit tables/ or erased tables is considered to be either taught by the Greenwood et al reference – see his description of edit tables.

Alternatively, Tholen et al also teaches the ability of creation of ""skip" tables and their inherent use.

It would have been obvious to one of ordinary skill in the art to modify the system of the above art as relied upon with respect to claim 2/12 with the teaching from either Greenwood et al or Official notice, motivation is to provide some inventory indication to the user of his records.

Although it is noted that the limitations of claim 20 also call for the above, because the examiner cannot properly ascertain the dependency of claim 20, no art rejection is presented. If claim 20 depends upon claim 24 and claim 24 depends upon claim 11, then the above analysis is repeated.

9. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al considered with Fujinami et al, all further considered with either Noguchi et al or Abecassis, and all further considered with either Hasegawa et al or WO 97/06531.

Claims 21 and 22 contain the limitations of claims 1 and 11 and dependent claims 23 & 24.

As indicated above in paragraph 3, Kondo et al, Fujinami et al and Noguchi et al/Abecassis are relied upon for their teachings. The additional backward jump, required in claims 21 and 22 is also found in the limitation(s) of claims 23 and 24, and either Hasegawa et al or WO 97/06531 are so relied upon for the backward directional ability, hence the ability to provide for a backward jump in order to increase the flexibility of the player.

Although the examiner only details the explanation to Kondo, inherently the rejection of the independent claims 1 & 11 as relying upon Aramaki et al (paragraph 4 above), Nagasawa (paragraph 5 above) are also viable. In order to reduce the issues before applicant, the examiner is not presenting rejections relying upon Aramaki and Nagasawa.

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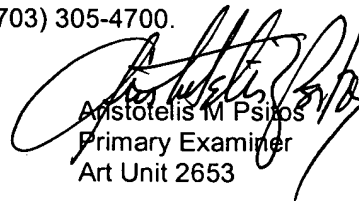
***Allowable Subject Matter***

Although the examiner indicated the subjection matter of claims & 14 as being allowable during the prosecution in the preceding action(s), discovery of the newly introduced reference(s) has necessitated the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
Aristotelis M Psitos  
Primary Examiner  
Art Unit 2653

AMP  
November 6, 2002